



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,070	04/26/2001	Dwip N. Banerjee	AUS920010179US1	8485

45440 7590 07/26/2005

IBM CORPORATION (SS)  
C/O STREETS & STEELE  
13831 NORTHWEST FREEWAY, SUITE 355  
HOUSTON, TX 77040

EXAMINER
----------

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
----------	--------------

3639

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/843,070

Applicant(s)

BANERJEE ET AL.

Examiner

Richard Woo

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-10, 12-16, 18-26, 28-30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-10, 12-16, 18-26, 28-30 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

- 1) Applicant's amendments filed on May 19, 2005 have been entered.
- 2) Applicant's arguments, filed on May 19, 2005, with respect to the rejection of Claims 1-33 under 35 U.S.C. 102(e) and rejection under 35 U.S.C. 101 have been fully considered and are persuasive. The rejection of Claims 1-33 has been withdrawn.

### ***Claim Rejections - 35 USC § 102***

- 3) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 4) Claims 1-5, 7-10, 12-16, 18-26, 28-30 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Lewis (US 2003/0040962).

As for Claim 1, Lewis discloses a method for pricing access to e-content comprising:

transmitting the e-content over a network to a computer along with a usage tracker for performing a step of tracking one or more usage characteristics (see paragraphs [0023], [0034], [0036], [0092], [0260]);

tracking one or more usage characteristics of an individual's access to e-content, wherein the one or more usage characteristics are selected from the group consisting of quantity of e-content accessed, quantity of time spent accessing the e-content, nature of the e-content, and combinations thereof (see *Id.*);

accepting return of the e-content from the computer along with the one or more usage characteristics (see paragraphs [0036], [0200]-[0205], [0216]); and

charging the individual a price that is determined as a predetermined function of the one or more usage characteristics (see *Supra* paragraphs).

As for Claim 2, Lewis further disclose the method, further comprising:

establishing a usage profile for the individual (see paragraph [0260]);

storing in the usage profile the one or more usage characteristics tracked during a first session (see *Supra* paragraphs regarding Rental embodiment); and

updating the usage profile to reflect the one or more usage characteristics tracked during a subsequent session (see *Id.*).

As for Claim 3, Lewis further discloses the method, wherein the step of updating the usage profile includes accumulating the one or more usage characteristics over a plurality of sessions (see *Id.*).

As for Claim 4, Lewis further discloses the method, wherein the price is determined as a predetermined function of the one or more usage characteristics of the current session, the one or more accumulated usage characteristics, or a combination thereof (see *Supra* paragraphs for rental).

Art Unit: 3639

As for Claim 5, Lewis further discloses the method, wherein the predetermined function is a non-linear function (see Supra charging method that does not have linear relationship to any data).

As for Claim 7, Lewis further discloses the method, wherein the step of accepting return includes receiving the entire e-content (see Supra paragraphs [0036], [0200]-[0205], [0216]).

As for Claim 8, Lewis further discloses the method, wherein the step of accepting return includes deleting the e-content from the individual's computer (see Id.).

As for Claim 9, Lewis further discloses the method including determining whether any copies of the transmitted e-content were made (see Id.).

As for Claim 10, Lewis further discloses the method, further comprising:

periodically receiving messages from the usage tracker indicating a change in the one or more usage characteristics (see paragraph [0260]).

As for Claim 12, Lewis discloses a computer system comprising:

transmitting means for transmitting the e-content over a network to a computer along with a usage tracker for performing a step of tracking one or more usage characteristics (see paragraphs [0023], [0034], [0036], [0092], [0260]);

tracking means for tracking one or more usage characteristics of an individual's access to e-content, wherein the one or more usage characteristics are selected from the group consisting of quantity of e-content accessed, quantity of time spent accessing the e-content, nature of the e-content, and combinations thereof (see Id.);

Art Unit: 3639

accepting means for accepting return of the e-content from the computer along with the one or more usage characteristics (see paragraphs [0036], [0200]-[0205], [0216]); and

charging means for charging the individual a price that is determined as a predetermined function of the one or more usage characteristics (see Supra paragraphs).

As for Claim 13, Lewis further discloses the system comprising:

establishing means for establishing a usage profile for the individual (see Supra Rental method including the customer database and paragraphs [0260]);

storing means for storing in the usage profile the one or more usage characteristics tracked during a first session (see Id.); and

updating means for updating the usage profile to reflect the one or more usage characteristics tracked during a subsequent session (see Id.).

As for Claim 14, Lewis further discloses the system, wherein the updating means includes accumulating means for accumulating the one or more usage characteristics over a plurality of sessions (see Supra paragraphs regarding the rental scheme and paragraph [0260]).

As for Claim 15, Lewis further discloses the system, wherein the price is determined as a predetermined function of the one or more usage characteristics of the current session, the one or more accumulated usage characteristics, or a combination thereof (see Supra rental embodiment).

Art Unit: 3639

As for Claim 16, Lewis further discloses the system, wherein the predetermined function is a non-linear function (see Supra charging method that does not have linear relationship to any data).

As for Claim 18, Lewis further discloses the system, wherein the accepting means includes receiving means for receiving the entire e-content (see Supra paragraphs [0036], [0200]-[0205], [0216]).

As for Claim 19, Lewis further discloses the system, wherein the accepting means includes deleting means for deleting the e-content from the individual's computer (see Id.).

As for Claim 20, Lewis further discloses the system including determining means for determining whether any copies of the transmitted e-content were made (see paragraph [0260]).

As for Claim 21, Lewis further discloses the system, further comprising:

receiving means for periodically receiving messages from the usage tracker indicating a change in the one or more usage characteristics (see paragraph [0260]).

As for Claim 22, Lewis discloses a computer program product including instructions embodied on a computer readable medium, the instructions comprising:

transmitting instructions for transmitting the e-content over a network to a computer along with a usage tracker for performing a step of tracking one or more usage characteristics (see paragraphs [0023], [0034], [0036], [0092], [0260]);

Art Unit: 3639

tracking instructions for tracking one or more usage characteristics of an individual's access to e-content, wherein the one or more usage characteristics are selected from the group consisting of quantity of e-content accessed, quantity of time spent accessing the e-content, nature of the e-content, and combinations thereof (see *Id.*);

accepting instructions for accepting return of the e-content from the computer along with the one or more usage characteristics (see paragraphs [0036], [0200]-[0205], [0216]); and

charging instructions for charging the individual a price that is determined as a predetermined function of the one or more usage characteristics (see *Supra* paragraphs).

As for Claim 23, Lewis further discloses the computer program product, further comprising:

establishing instructions for establishing a usage profile for the individual (see *Supra* paragraphs regarding the rental embodiment and paragraph [0260]);

storing instructions for storing in the usage profile the one or more usage characteristics tracked during a first session (see *Id.*); and

updating instructions for updating the usage profile to reflect the one or more usage characteristics tracked during a subsequent session.

As for Claim 24, Lewis further discloses the computer program product, wherein the updating instructions include accumulating instructions for accumulating the one or



Art Unit: 3639

more usage characteristics over a plurality of sessions (see Supra paragraphs regarding the rental scheme and paragraph [0260]).

As for Claim 25, Lewis further discloses the computer program product, wherein the price is determined as a predetermined function of the one or more usage characteristics of the current session, the one or more accumulated usage characteristics, or a combination thereof (see Id.).

As for Claim 26, Lewis further discloses the computer program product, wherein the predetermined function is a non-linear function (see Supra charging method that does not have linear relationship to any data).

As for Claim 28, Lewis further discloses the computer program product, wherein the accepting instructions includes receiving means for receiving the entire e-content (see paragraphs [0036], [0200]-[0205], [0216]).

As for Claim 29, Lewis further discloses the computer program product, wherein the accepting instructions includes deleting means for deleting the e-content from the individual's computer (see Id.).

As for Claim 30, Lewis further discloses the computer program product, wherein the accepting instructions for determining whether any copies of the transmitted e-content were made (see paragraph [0260]).

As for Claim 32, Lewis discloses a method for providing access to e-content on a server, comprising:

Art Unit: 3639

transmitting e-content from the server to a client computing device along with an embedded usage tracking program (see paragraphs [0023], [0034], [0036], [0092], [0260]);

receiving the usage report from the usage tracking program, one or more characteristic of the client's access to the e-content (see Id.);

determining whether the client's access to the e-content exceeds an expiration set-point (see Supra paragraphs and paragraphs [0036], [0200]-[0205], [0216]); and

upon a determination of expiration, deleting the e-content from the client computer (see Id.).

### ***Conclusion***

5) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 2002/0111912 is cited to show a music distribution system in which music is blanket transmitted to each customer's user station where selected music files are recorded. An anti-piracy ID tag is woven into the recorded music so that any illegal copies may be traced to the purchase transaction.

US 2002/0073033 is cited to show an online digital video signal transfer apparatus and method that provides access to an online catalog stored within a memory of a network video server. Once e-payment is provided, the video signal is transmitted to the client computer.

Art Unit: 3639

US 2001/0023412 is cited to show a digital distribution method and system that are applied to the distribution of books, documents, music CDs and DVDs. When the contents availability period expires, the control program erases the digital contents or erases itself in conjunction with the digital contents.

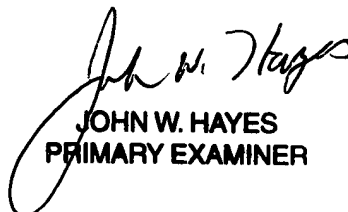
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 571-272-6813. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Woo  
Art Unit 3639  
July 18, 2005



JOHN W. HAYES  
PRIMARY EXAMINER